

### REMARKS

This responds to the Office Action mailed December 5, 2006.

Claim 32 is canceled without prejudice, and claims 34-36 are added. Thus, claims 1 and 34-36 are pending.

Support for new claims 34-36 can be found at various places in the specification including, for example, in the originally-filed claim 32, as well as at page 12, line 26 - page 13, line 2; page 32, line 31 - page 33, line 4; page 33, lines 24-26; and page 13, line 18 - page 14, line 3.

#### §112 Rejection of the Claims

Claim 32 was rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description. This rejection is now moot as Applicants have cancelled claim 32.

Applicants note, however, that claim 32 was directed to a variant of SEQ ID NO: 1 that has particular amino acid residues at identified positions, and support for the subject matter of this claim can be found at various places throughout the specification including, for example, Figure 2B; page 32, line 31 to page 33, line 4; and page 33, lines 24-26. In other words, Applicants cancel claim 32 to facilitate prosecution and not to concede to the correctness of the Examiner's assertion. Thus, claim 32 is cancelled without prejudice to continued prosecution.

#### §102 Rejection of Claim 1

The Examiner rejected claim 1 under 35 U.S.C. § 102(b) as anticipated by Scherl-Mostageer *et al.* (*Oncogene* 20: 4402-4408 (2001)). The Examiner alleged that since the CDCP1 sequence disclosed in Figure 2 of the Scherl-Mostageer *et al.* reference was corrected on March 7, 2006 resulting in a sequence that is 100 % identical to SEQ ID NO: 1, the CDCP1 sequence of the Scherl-Mostageer *et al.* reference inherently anticipates SEQ ID NO: 1. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the CDCP1 sequence shown in Figure 2 of the Scherl-Mostageer *et al.* reference actually differs from SEQ ID NO: 1 at two positions – residues 525 and 827 – not one as stated in the Office Action of Dec. 5, 2006. In addition, even if Scherl-Mostageer *et al.* corrected the CDCP1 sequence of Figure 2, the “corrected” sequence is not necessarily “inherent” in the CDCP1 protein discussed in the Scherl-Mostageer *et al.* reference.

According to the M.P.E.P., "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (cited in M.P.E.P. § 2112.IV, page 2100-47) (citation omitted). Therefore, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (cited in M.P.E.P. § 2112.IV, page 2100-48) (emphasis in original).

Scherl-Mostageer *et al.*'s submission of a "corrected" sequence for its CDCP1 protein in 2007 does not indicate that at the time of their original disclosure in 2001, Scherl-Mostaggar *et al.* must necessarily have a CDCP1 protein sequence of SEQ ID NO: 1. On the contrary, the original sequence shown in Figure 2 of the Scherl-Mostaggar *et al.* reference, which differs from SEQ ID NO: 1 at positions 525 and 827, indicates that Scherl-Mostaggar *et al.* did not, in fact, have a protein sequence of SEQ ID NO: 1. Furthermore, Scherl-Mostageer *et al.* obtained the CDCP1 sequence from sequencing a PCR product amplified from a cDNA library, which itself was generated by reverse transcription from isolated RNA. See the Scherl-Mostaggar *et al.* reference, at page 4402 ("The full-length sequence was amplified as demonstrated in Figure 2."); see also *id.*, at page 4404, Figure 2, legend. Since "errors" could be introduced during reverse transcription to generate the cDNA product or during amplification to generate the PCR product, the "correct" sequence is not necessarily an inherent feature in the Scherl-Mostaggar *et al.*'s original CDCP1 sequence. In other words, Applicants respectfully submit that there is insufficient basis in fact and/or technical reasoning to reasonably support the determination that in 2001, Scherl-Mostaggar *et al.* must necessarily have a CDCP1 protein sequence of SEQ ID NO: 1.

Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claim 1.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Wendy Thai, at (612) 373-6913 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

JAMES P. QUIGLEY ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

(612) 373-6913

Date

April 4/07

By

W. Thai

Wendy Thai, Ph.D., J.D.

Reg. No. 53,684

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4th day of April 2007.

CANDIS BUENDING

Name

Signature

